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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

|                           |   |
|---------------------------|---|
| Proceeding                | 91208648  |
| Party                     | Defendant<br>John C Horton  |
| Correspondence<br>Address | JOHN C HORTON<br>1719 CAROLINA AVE<br>WILMINGTON, NC 28403-1001<br>UNITED STATES<br>jhorton@wilmington1.com |
| Submission                | Answer  |
| Filer's Name              | John C Horton   |
| Filer's e-mail            | jhorton@dropbox.mobi  |
| Signature                 | /John C Horton/   |
| Date                      | 03/21/2013  |
| Attachments               | Answer 20130321.pdf ( 8 pages )(47962 bytes )<br>Request to file late answer.pdf ( 1 page )(37578 bytes )   |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Application Serial No. 85/584,161 Mark: DROPBOX MOBI  
Published: September 04, 2012

DROPBOX, INC., Opposer, v. John C Horton, Applicant.

Opposition No. 91208648

APPLICANT'S ANSWER TO OPPOSER'S NOTICE OF OPPOSITION AND  
COUNTERCLAIMS

John C Horton ("Applicant") answers the Notice of Opposition filed by Dropbox, Inc. ("Dropbox") as follows:

1. With respect to paragraph 1 of the Notice of Opposition, Applicant denies that Dropbox became a "global provider of digital content hosting, sharing, and synchronization services" until after the company's official product launch on September 8, 2008. The company was not accessible via the World Wide Web as <http://www.dropbox.com>, nor possessed rights to the associated Internet Domain Name until 2009. Dropbox's official Internet Domain Name was "getdropbox.com" until October 2009. With regard to the remaining allegations of paragraph 1, Applicant is without information or knowledge sufficient to form a belief as to the truth of the allegations, and therefore, denies same.

2. With respect to paragraph 2 of the Notice of Opposition, Applicant denies that Dropbox owns common law rights to the word DROPBOX. The use of "DROPBOX" alone in common language describes a box for holding payments or shuttles on a loom. Prior to the advent of the Internet, Electronic Data Interchange transactions frequently between financial entities, often intermediated by "dropbox" entities. This has nothing to do with file sharing or storage. Applicant admits Opposer did file Application Ser. No. 77/817,716 for the mark DROPBOX. The Applicant denies that this application date, September 1, 2009, is prior to any date to which Applicant can reply. Applicant developed a business plan and secured the Internet Domain Name rights to DROPBOX.MOBI in 2006, prior to Opposer's company formation. The DROPBOX.MOBI domain name has been publicly accessible since October 17, 2006 and Applicant is the original registrar of the domain name associated with Applicant's Trademark Application. .

3. With respect to paragraph 3 of the Notice of Opposition, Applicant denies that Opposer's assertion that the scope of Application Ser. No. 77/817,716 has any bearing on the Applicants scope on Application Ser. No. 85/584,161. There is no overlap between scopes. No dilution is therefore possible if Application Ser. No. 77/817,716 is awarded.

4. With respect to paragraph 4 of the Notice of Opposition, Applicant admits he is an individual at the stated address.

5. With respect to paragraph 5 of the Notice of Opposition, Applicant admits the stated intent-to-use basis is present in Application Ser. No. 85/584,161.

6. With respect to paragraph 6 of the Notice of Opposition, Applicant denies that Opposer has priority over Applicant. Opposer has no common law right in or to its DROPBOX mark as supported by dictionary definitions, etymologic resources, industry trade material, other on-going trademark challenges in TSDR. The Applicant's own business plan and Domain Name registration ownership of <http://dropbox.mobi> are both dated 2006. Applicant incorporates by reference all documents in the TTABVue system of the Trademark Trial and Appeal Board that contain the marks "DROPBOX", "BOX", "BOX.NET", "OPENBOX", "FETCHBOX". Trademark suits filed in the Dallas federal court in July, 2008

7. With respect to paragraph 7 of the Notice of Opposition, Applicant denies the its mark is confusingly similar. Countless two word concatenations with separate and distinct sight, sound, connotation and commercial impressions exist within US Trademarks. There is no precedent for single-word exclusions limiting whole mark inclusion in Trademarking that the Applicant is aware of. Sight and sound are different upon simple inspection. Connotation, as mentioned in prior responses, has no overlap whatsoever with Applicant's view of a dropbox being aligned with the more common financial industry denotation as indicated by the application's scope. To reinforce the different commercial impression, the ".mobi" top-level domain (TLD) in the Domain Name System of the Internet., became available for registration September 26, 2006, shortly after which the Applicant took action to register the "DROPBOX.MOBI" web address to support his business plan. These web addresses, by their very nature, were created to invite mobile device interactions. As the mobile industry matured and mobile financial transaction processing became viable, the Applicant sought to secure the associated mark.

8. With respect to paragraph 8 of the Notice of Opposition, Applicant denies the

goods identified in the Applicant's Application are identical, overlapping, and/or commercial related to the goods and services covered by the Opposer's reference application. The Applicant's Application includes:

“Computer software for authorizing and processing credit cards, debit cards, check cards, checks, electronic checks by merchants on mobile telephones, personal digital assistants, pagers, hand-held computers, laptop computers; computer software for providing credit card payment and payment by check by automated clearing house (ACH) conversion in a wireless point-of-sale transaction for use by mobile retailers that may be downloaded from a global computer network” in Class 9.

In contrast, the Opposer's Application for its DROPBOX mark does not overlap the authorization or processing mentioned, covering instead different commercial activities:

“Computer software and downloadable computer software used to store and share data, documents, files, information, text, photos, images, graphics, music, audio, video, and multimedia content with others via global computer networks, mobile telephones, and other communications networks for the purpose of file back up and synchronization, not including software for use in database management in the field of life sciences research or software for uploading or transferring advertising programs and media advertising communications” in Class 9;

“Storage of electronic media, namely, data, documents, files, text, photos, images, graphics, music, audio, video, and multimedia content” in Class 39; and  
“Providing temporary use of non-downloadable computer software used to store and share data, documents, files, information, text, photos, images, graphics, music, audio, video, and multimedia content with others via global computer networks, mobile telephones, and other communications networks for the purpose of file back up and synchronization, not including software for use in database management in the field of biomedical research or software for uploading or transferring advertising programs and media advertising communications; hosting of digital content on the internet” in Class 42.

9. With respect to paragraph 9 of the Notice of Opposition, Applicant denies that the goods identified in its Application would be offered to the same, substantially similar or overlapping consumers as the Opposer's Application. The former Application addresses the needs of the payment needs of consumers and merchants, as captured in its Class 9 scope above. The Opposer's Application

addresses file downloading.

10. With respect to paragraph 10 of the Notice of Opposition, Applicant denies that goods associated with the Applicant and Opposer Applications would be offered through the same, substantially similar, and/or overlapping channels of trade. Financial transaction processing and file storage businesses use completely distinct channels to market with distinct primary and secondary distribution markets, sales compensation schemes and operational concerns. Applicant denies Opposers inference that the Internet or mobile applications channels in themselves may be considered Opposers exclusive channel to advertise, market and sell goods. There can be no overlapping channels of trade, as to the best of Applicants knowledge, Opposers does not own the internet or mobile application pathway.

11. With respect to paragraph 11 of the Notice of Opposition, Applicant denies the Opposer's claim or priority as the Applicant secured the "DROPBOX.MOBI" domain name, developed a business plan in 2006, prior to the existence of the Opposer's incorporated entity, any subsequent customer base, corporate name change or Trademark Application. Applicant has had a visible public presence with a Internet Domain Name advertised across the world as DROPBOX.MOBI since mobile (.MOBI) domain names became available in 2006 and the Applicants registration of the domain name specifically on October 17,2006. This precedes and commercial or even known development activities of the Opposer. The Opposer, before incorporating with that name or pursuing product or domain names made no effort to contact Applicant.

12. With respect to paragraph 12 of the Notice of Opposition, Applicant denies the allegations therein. Applicant has been a satisfied customer of Opposer's and several other competing commercial file sharing services. Applicant repeatedly called and sent registered mail to Opposed in an attempt to avoid any Trademark ownership disagreements and get Applicant's product to market by 2013. Due to lack of clarity on mark ownership, investments have stalled.

13. With respect to paragraph 13 of the Notice of Opposition, Applicant denies the Applicant's Mark registered with the goods enumerated above in paragraph 8 would have any impact on the Opposer's business, being of a separate and distinct field of use and customer base, and that Opposer has any superior rights to the DROPBOX mark, given the Opposer's application status and the lack of date priority cited above.

14. With respect to paragraph 14 of the Notice of Opposition, Applicant admits

the marks are similar, one included by the other; a common practice. With insufficient information or knowledge sufficient to form a belief as to the truth of the allegations, Applicant therefore, denies all other aspects of the paragraph 14. Applicant states the underlying goods are distinct and different, as mentioned multiple times above. The Applicant seeks a mark descriptive of its Domain Name Registration and the industry act which it performs. Insomuch, a mark descriptive of the business Applicant is in will serve to differentiate and avoid consumer "confusion". Opposer is without any quantitative consumer sentiment as to whether there is or will be name confusion or dilution, and whether that would be good or bad for the Opposer now or in the future. Opposer has no evidence of any actual nor any viable model to predict future confusion by consumers caused by Applicant's use of the DROPBOX MOBI mark.

15. With respect to paragraph 15 of the Notice of Opposition, Applicant denies that the public would erroneously assume or believe Applicant's mobile financial transaction products emanate from Opposer, who is in the file storage and sharing business. The Opposer has a family of mobile file storage and sharing applications deployed today and enjoys significant market share with no confusion with other products featuring DROPBOX in their collateral or product definitions. Even less confusion is likely to occurs with the Applicant that is in a separate and distinct business operating exclusively in the .mobi domain.

16. With respect to paragraph 16 of the Notice of Opposition, Applicant denies the allegation that registration and use of Applicant's mark will suggest a connection to the Opposer and/or Opposer goods and/or services. As outlined above, former denotes and connotes mobile financial transaction processing; the latter file storage and sharing. Widespread uses of the words "drop", "box" and "mobi" in trademarks registered with the United States Patent and Trademark Office pre-date Opposer's existence by decades. As of March 20, 2013, 359 US Trademarks include the word "MOBI" (130 punctuated, 187 separate and 42 integrated), many in a concatenated format similar to Applicant's mark. To the best of the Applicant's knowledge, no similar allegations of potential loss, damage or injury have been levied in opposition to these marks.

17. With respect to paragraph 17 of the Notice of Opposition, Applicant denies the allegations therein. The word "BOX" is included in over 14,000 marks, most of them in a trailing situation. By searching for storage- or file sharing concept in these marks, no less than 133 issued Trademarks contain verbiage that matches the criteria proposed by the Opposer as violating the Federal Trademark Dilution Act. As and example Applicant sites this type of web query: <http://tess2.uspto.gov/bin/showfield?f=toc&state=4004%3Akntw3x>.

1.1&p\_search=searchstr&BackReference=&p\_L=100&p\_plural=yes&p\_s\_PARA1=box&p\_tagrepl~%3A=PARA1%24MP&expr=PARA1+and+PARA2&p\_s\_PARA2=file&p\_tagrepl~%3A=PARA1%24MP&a\_default=search&f=toc&state=4004%3Akntw3x.1.1&a\_search=Submit+Query

18. Any allegations within the Notice of Opposition not already specifically admitted or denied herein, are hereby denied.

#### FIRST AFFIRMATIVE DEFENSE

19. Opposer does not have the exclusive right to use the term "DROPBOX" because the primary significance of the term is an indication of the nature or class of the product or service provided by Opposer and is not an indicator of source. The term was in common use in the English language well before Opposer began using the term in connection with its services. The term is used generically by many members of the public and by a wide variety of organizations. Because the term "DROPBOX" was used by many parties descriptively and generically well before Opposer's date of first use of the term, the term standing alone is generic and incapable of trademark protection under the laws of the United States.

#### SECOND AFFIRMATIVE DEFENSE

20. Opposer's opposition should be denied under the equitable doctrine of unclean hands. Opposer has engaged in trademark misuse and trademark bullying by abusively using oppositions, litigation, and threats of the same to maintain a competitive market advantage. Opposer refused to respond to requests to communicate on the issue of the "DROPBOX MOBI" mark and dropbox.mobi domain name via email, telephone and register US Mail from the Applicant in 2011. For these reasons as well as those outlined in Applicant's counterclaims below, the opposition should be denied.

#### THIRD AFFIRMATIVE DEFENSE

21. Opposer's mark does not qualify for anti-dilution protection of the Lanham Act because the term DROPBOX alone is highly diluted already by others using identical or very similar marks, including numerous uses of the term "box" and "drop" in connection with file storage and sharing websites. Opposer's attempt to seek anti-dilution protection is arbitrary and inconsistent. Opposer has not contested the use of the word "DROPBOX" in other marks such as "DROPBOX ARC", US Registration Number 3124425, having a scope of use similar to Applicant's Application. "DROPBOX", US Registration Number 3003912 references computer software downloads and was not challenged by the

Opposer. "DROPBOX", US Registration Number 2595861, references goods and services including "plastic containers in the nature of discharging pallet boxes for commercial and industrial use", has not been opposed by Opposer. The mark "DICOM DROPBOX", US Serial Number 85/591875, covers "Computer software, namely, software for privacy protected exchange of medical image information comprising receiving, analyzing, modifying, encrypting, compressing, auditing and secure digital transfer features.", while overlapping Opposer's Application, has also not been opposed by Opposer. DROPBOX MOBI products and services are distinct and have no overlap with products and services offered by DROPBOX, INC. DROPBOX, INC is attempting to claim exclusivity to the internet and mobile application marketplace/channels for products and services offered by DROPBOX MOBI and not offered by DROPBOX, INC.

#### FOURTH AFFIRMATIVE DEFENSE

22. There is no likelihood of confusion between Applicant's proposed mark and the mark cited by Opposer even reading the description of Applicant's services broadly. Alternatively, Applicant is only using the mark in connection with its financial transaction processing related services, and as such, there is no likelihood of confusion with respect to the actual services provided by Applicant as Opposer does not provide these services.

#### FIFTH AFFIRMATIVE DEFENSE

23. All of the pertinent applications cited by Opposer against the registration of Applicant's mark should be denied, or in the alternative, restricted to goods and services related to the services actually provided by Opposer, namely an online file storage and sharing.

#### SIXTH AFFIRMATIVE DEFENSE

24. In addition to numerous uses by third parties and trade press, Opposer has actually used the term "DROPBOX" in a generic sense, and is estopped from now claiming that it is not generic.

Date: March 21, 2013

Respectfully submitted,



By:

John C Horton

## **REQUEST TO FILE LATE ANSWER**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Application Serial No. 85/584,161 Mark: DROPBOX MOBI  
Published: September 04, 2012

DROPBOX, INC., Opposer, v. John C Horton, Applicant.

Opposition No. 91208648

**3/21/13**

To Whom it may concern,

I hereby request additional time to file my answer and that the TRADEMARK  
TRIAL AND APPEAL BOARD accept the attached  
Answer for filing in this case (Opposition No. 91208648) as of this date. This is  
in response to the letter attached, dated 2/21/2013.

I didn't file the answer within the allowed time because of the limited time made  
available to me by my advisor to answer the Opposers opposition.

Respectfully submitted,

John C Horton